

REMARKS

The Office Action mailed March 5, 2009 has been received and reviewed. Each of claims 43, 48-60, and 62-77 stands rejected. Claims 43, 60, 72, and 74-77 have been amended herein. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

Rejections based on 35 U.S.C. § 101

Claims 74-77 have been rejected under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. More particularly, the Office Action indicates that because claim 74 recites “computer-readable media having computer-readable instructions embodied thereon,” the claimed invention includes communication media and wireless media. Additionally, the Office Action emphasizes that the use of the term “storing” instead of “embodied” in claim 72 is a direct contrast, and that use of the term “storing” “necessarily includes a computer hardware component.” *Office Action*, p. 3.

Independent claim 74 has been amended herein, consistent with the observations of the Office Action, to recite, in part, “[o]ne or more computer-readable media storing computer-executable instructions” Accordingly, it is respectfully submitted that amended independent claim recites statutory subject matter. Each of claims 75-77 depends directly from amended independent claim 74. Therefore, Applicants respectfully submit that each of claims 75-77 recites statutory subject matter at least due to its dependency from amended independent claim 74. Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejections of claims 74-77.

Rejections based on 35 U.S.C. § 112

Claims 60 and 62-73 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More particularly, with respect to claims 60 and 62-71, the Office Action asserts that the Specification does not mention “devices installed on a computing device.” Independent claim 60 has been amended herein to recite, in part, “[a] system for accessing and manipulating device information for devices attached to a computing device having a hardware and devices folder that uses a function discovery database to enumerate a list of all devices attached to the computing device.” *See, e.g., Specification*, p. 5, line 27 – p. 6, line 5. Applicants respectfully submit that the subject matter of the amended claim is described in the Specification. Accordingly, Applicants respectfully submit that amended independent claim 60 complies with the written description requirement set forth in 35 U.S.C. § 112, first paragraph. Additionally, Applicants respectfully submit that each of claims 62-71 complies with the written description requirement set forth in 35 U.S.C. § 112, first paragraph, at least by reason of their dependency from claim 60. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejections of claims 60 and 62-71.

The Office Action further asserts that the Specification fails to support the previously presented recitation in claim 72 of a “control bar comprising a plurality of mechanisms for manipulating devices,” but rather describes a “control bar comprising a plurality of mechanisms for manipulating information about the devices.” *Office Action*, p. 5. Independent claim 72 has been amended herein to recite a “control bar comprising a plurality of mechanisms for manipulating information about the devices. Accordingly, Applicants respectfully submit that amended independent claim 72 complies with the written description requirement set forth in 35 U.S.C. § 112, first paragraph. Additionally, Applicants respectfully

submit that claim 73 complies with the written description requirement set forth in 35 U.S.C. § 112, first paragraph, at least by reason of its dependency from claim 72. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejections of claims 72 and 73.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

To sustain a rejection of a claim under 35 U.S.C. § 103(a), the Examiner must find that a preponderance of the evidence supports a finding of obviousness. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02(I) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. MPEP § 2142, citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007), which notes that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. Moreover, the Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the

legal conclusion of obviousness." MPEP § 2142 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

B. 35 U.S.C. § 103(a) Rejection Based upon Boldt in view of Strittmatter in further view of Chiloyan

Claims 43, 48-60 and 62-77 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Boldt et al., U.S. Patent No. 6,349,304 (hereinafter "Boldt") in view of Strittmatter et al., U.S. Publication No. 2004/0176118 (hereinafter "Strittmatter") in further view of Chiloyan et al., U.S. Publication No. 2002/0083228 (hereinafter "Chiloyan"). As the asserted combination of references fails to teach or suggest all of the limitations of claims 43, 48-60, and 62-77, Applicants respectfully request withdrawal of the rejections of these claims.

1. Claims 43 and 48-59

Amended independent claim 43 recites, in part, "displaying a common file dialog comprising a plurality of icons representing all of the relevant devices such that representations of all of the relevant devices are provided within a single display area, wherein the common file dialog provides a consistent way for each of a plurality of applications to present devices to a user and to receive device selections from the user." Applicants are unable to find in any of the cited references any disclosure of displaying a common file dialog that provides a consistent way for each of a plurality of applications to present devices.

To the contrary, Boldt discloses providing "an improved method and system for allowing a user, such as a network administrator, to copy the values for selected features from one device or file to multiple devices, such as printers, over a network." *Boldt*, col. 2, lines 12-15. Not surprisingly, Boldt only describes providing a dialog in the context of this program module. See, generally, *Boldt*, col. 6, line 20 – col. 9, line 48 (describing a "wizard," that guides

a user “through a series of steps to configure the values of features” for multiple target devices). Applicants are unable to find any in Boldt any disclosure of using a common file dialog to present devices and allow device selection in a consistent manner between a plurality of applications.

Applicants respectfully submit that Strittmatter neither fails to cure the deficiencies of Boldt in at least this regard, nor is relied upon by the Office Action as doing so. Applicants are unable to find in Strittmatter any disclosure of using a common file dialog to present devices and allow device selection in a consistent manner between a plurality of applications. Moreover, Chiloyan fails to cure the deficiencies of Boldt and Strittmatter in at least this regard. Although Chiloyan does disclose displaying an enumerated list of devices, that disclosure is directed to a user running the Device Manager program, which “displays a list of all hardware devices connected to the host personal computer.” *Chiloyan*, ¶ [0053]. However, this disclosure makes reference to only a single application program – Device Manager – that displays devices in a particular way. *Id.* Applicants are unable to find any in Chiloyan any disclosure of using a common file dialog to present devices and allow device selection in a consistent manner between a plurality of applications.

Additionally, Applicants respectfully submit that any attempt to combine teachings of a reference with the disclosure of Boldt to render obvious the claimed invention, in which a common file dialog provides a consistent way for each of a plurality of applications to present devices and to receive device selections from a user, would likely not be sufficient to render amended claim 43 *prima facie* obvious because such a modification of Boldt would change the principal of operation of the invention disclosed in Boldt. As discussed above, the invention disclosed in Boldt is designed to perform the task of copying configuration settings

from one device or file to one or more other devices or files. *See, e.g., Boldt*, col. 2, lines 12-15. The principal of operation utilized to allow a user to perform that task includes providing a “GUI interface to sequence the user through a series of steps to configure the values of features” for multiple target devices. *See, e.g., id.* at col. 7, lines 55-64.

Modifying the user interface (e.g., “dialog”) disclosed in *Boldt* with the teachings of a reference to create the claimed common file dialog that presents devices for selection in a consistent manner between multiple applications “would require a substantial reconstruction and redesign of the elements shown in [*Boldt*] as well as a change in the basic principle under which the [*Boldt*] construction was designed to operate.” *See In re Ratti*, 270 F.2d at 813, 123 USPQ at 3521. Individuals having ordinary skill in the art will understand that the attribute-copying “wizard” program disclosed in *Boldt* is completely different than the common file dialog of the claimed invention. In particular, the recited common file dialog does not include any features or functionality for guiding a user through a process of updating devices, but rather presents a set of selectable devices and information pertaining thereto. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01(VI), citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Accordingly, Applicants respectfully submit that any attempt to combine a reference with the disclosure in *Boldt* to render obvious the claimed common file dialog would likely not be sufficient to render amended claim 43 *prima facie* obvious.

Accordingly, it is respectfully submitted that, for at least the above-cited reasons, the asserted references, whether taken alone or in combination, cited in the Office Action fail to teach or suggest all of the limitations of amended independent claim 43. Thus, Applicants

respectfully submit that the asserted combination of references fails to render amended independent claim 43 obvious. Each of claims 48-59 depends, either directly or indirectly, from amended independent claim 43. Accordingly, it is respectfully submitted that the cited art of record fails to render obvious these dependent claims for at least the above-cited reasons. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that claims 43 and 48-59 are patentable over the cited art of record and request withdrawal of the 35 U.S.C. § 103(a) rejections thereto.

2. Claims 60 and 62-71

Amended independent claim 60 recites, in part, "wherein the display device displays a common file dialog comprising a plurality of icons representing all of the devices in the filtered subset such that representations of all of the devices in the filtered subset are provided within a single display area, and further wherein the common file dialog presents devices in the same way for each of the plurality of applications." As discussed above with reference to amended independent claim 43, Applicants are unable to find in any of the cited references any disclosure of displaying a common file dialog that provides a consistent way for each of a plurality of applications to present devices.

Accordingly, it is respectfully submitted that, for at least the above-cited reasons, the asserted references, whether taken alone or in combination, cited in the Office Action fail to teach or suggest all of the limitations of amended independent claim 60. Thus, Applicants respectfully submit that the asserted combination of references fails to render amended independent claim 60 obvious. Each of claims 62-71 depends, either directly or indirectly, from amended independent claim 60. Accordingly, it is respectfully submitted that the cited art of

record fails to render obvious these dependent claims for at least the above-cited reasons. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that claims 60 and 62-71 are patentable over the cited art of record and request withdrawal of the 35 U.S.C. § 103(a) rejections thereto.

3. Claims 72 and 73

Amended independent claim 72 recites, in part, “wherein the display device displays a common file dialog comprising a plurality of icons representing all of the devices in the filtered subset such that representations of all of the devices in the filtered subset are provided within a single display area, and further wherein the common file dialog provides a consistent way for each of the plurality of applications to present devices to a user and to receive device selections from the user.” As discussed above with reference to amended independent claims 43 and 60, Applicants are unable to find in any of the cited references any disclosure of displaying a common file dialog that provides a consistent way for each of a plurality of applications to present devices.

Accordingly, it is respectfully submitted that, for at least the above-cited reasons, the asserted references, whether taken alone or in combination, cited in the Office Action fail to teach or suggest all of the limitations of amended independent claim 72. Thus, Applicants respectfully submit that the asserted combination of references fails to render amended independent claim 72 obvious. Claim 73 depends directly from amended independent claim 72. Accordingly, it is respectfully submitted that the cited art of record fails to render obvious this dependent claim for at least the above-cited reasons. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03,

citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that claims 72 and 73 are patentable over the cited art of record and request withdrawal of the 35 U.S.C. § 103(a) rejections thereto.

4. Claims 74-77

Amended independent claim 74 recites, in part, “displaying a common file dialog comprising a plurality of icons representing all of the relevant devices such that representations of all of the relevant devices are provided within a single display area, wherein the common file dialog provides a consistent way for each of a plurality of applications to present devices to a user and to receive device selections from the user.” As discussed above with reference to amended independent claims 43, 60, and 72, Applicants are unable to find in any of the cited references any disclosure of displaying a common file dialog that provides a consistent way for each of a plurality of applications to present devices and to receive device selections from a user.

Accordingly, it is respectfully submitted that, for at least the above-cited reasons, the asserted references, whether taken alone or in combination, cited in the Office Action fail to teach or suggest all of the limitations of amended independent claim 74. Thus, Applicants respectfully submit that the asserted combination of references fails to render amended independent claim 74 obvious. Each of claims 75-77 depends directly from amended independent claim 74. Accordingly, it is respectfully submitted that the cited art of record fails to render obvious these dependent claims for at least the above-cited reasons. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that claims 74-77 are patentable over the cited art of record and request withdrawal of the 35 U.S.C. § 103(a) rejections thereto.

Each of claims 43, 48-60, and 62-77 is believed to be patentable and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 43, 48-60, and 62-77 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or twilhelm@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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